

REMARKS:

Claims 1-38 are pending in this application. Claims 4, 16, 19, 23, 36 and 38 have been withdrawn from consideration. Claims 1, 10, 11, 20, 30 and 31 have been amended herein.

In the Office Action mailed November 28, 2005, (hereinafter "Office Action") the examiner has identified a Election/Restriction requirement to the following patentably distinct species of the following genii of the claimed invention:

A) For the first Genii.

- a. wherein the blocked mercaptosilane is as in claims 3 and 22.
- b. wherein the blocked mercaptosilane is as in claims 4, 19, 23 and 38.

B) For the second Genii.

- a. wherein the G is a substituted phenyl group (claims 16 and 36).
- b. wherein the G is a substituted alkyl group (claims 17, 18 and 37).

In a telephone conversation with Peter G. Dilworth on November 16, 2005, a provisional election was made with traverse to prosecute the invention of species A) a and B) b, Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37. Applicants herein affirm this election with traverse.

The Examiner has rejected Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 under 35 U.S.C. § 102 (b) as anticipated by Bomal et al. Australian Patent Application No. AU-A-199710082 (hereinafter, "Bomal et al. application"). The Examiner has stated that "In page 8, lines 6-10 and page 30, line 1 to page 33, line 10 Bomal et al. teach rubber compositions comprising, at least one elastomer (rubber), a filler and a blocked mercaptosilanes represented by formulas (1) or (2) in applicant's presently claimed invention." (Office Action, page 4, paragraph 2). Applicants disagree with the Examiner's contentions. It is noted to the Examiner that Bomal et al. application stipulates that compositions of the structures of Formula (I) or (IV) must be used in conjunction with functionalized siloxanes. In addition, nowhere in Bomal et al. application is there any motivation, hint or suggestion of using the compounds of Formula(s) (I)

and/or (IV) as latent mercaptosilane coupling agents, nor is there any disclosure, motivation, hint or suggestion of the use of these compounds in any way which would give rise to the advantages of using them as a source of latent mercaptosilane. The Examiner is respectfully requested to indicate with specificity as to page and line number where Formula(s) (I) and/or (IV) are disclosed or suggested as a source of latent mercaptosilane. In any event, applicants have amended Claims 1, 10, 11, 20, 30, and 31 herein to remove formula (2) from said claims. Nowhere in Bomal et al. application is there any disclosure, motivation, hint or suggestion of the previously claimed and/or presently claimed composition as amended. The Examiner is respectfully requested to indicate with specificity as to page and line number where formula (1) is disclosed or suggested in Bomal et al. application. In addition the Examiner is requested to indicate with specificity as to page and line number the disclosure or suggestion of a deblocking agent and a curing agent and the showing of allowing the composition to cure. Absent such noted showing of disclosures or suggestions, Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 are patentable over Bomal et al. application and thus withdrawal of the rejection to Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 is respectfully requested.

In addition, applicants have submitted Bomal et al. Australian Patent No. 730753 (hereinafter, "Bomal et al. patent"). The same arguments applied to Bomal et al. application apply with equal force herein. It is noted to the Examiner that Bomal et al. patent stipulates that compositions of the structures of Formula (I) or (IV) must be used in conjunction with functionalized siloxanes. In addition, nowhere in Bomal et al. application is there any motivation, hint or suggestion of using the compounds of Formula(s) (I) and/or (IV) as latent mercaptosilane coupling agents, nor is there any disclosure, motivation, hint or suggestion of the use of these compounds in any way which would give rise to the advantages of using them as a source of latent mercaptosilane. The Examiner is respectfully requested to indicate with specificity as to page and line number where Formula(s) (I) and/or (IV) are disclosed or suggested as a source of latent mercaptosilane. In any event, applicants have amended Claims 1, 10, 11, 20, 30, and 31 herein to remove formula (2) from said claims. Nowhere in Bomal et al. patent is there any disclosure, motivation, hint or suggestion of the previously claimed and/or presently claimed composition as amended. The Examiner is respectfully requested to indicate

with specificity as to page and line number where formula (1) is disclosed or suggested in Bomal et al. patent. In addition the Examiner is requested to indicate with specificity as to page and line number the disclosure or suggestion of a deblocking agent and a curing agent and the showing of allowing the composition to cure. Absent such noted showings of disclosures or suggestions, Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 are patentable over Bomal et al. patent and thus withdrawal of the rejection to Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 is respectfully requested.

The Examiner has rejected Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 under 35 U.S.C. § 102 (b) as anticipated by Takeshita et al. U.S. Patent No. 4,820,751 (hereinafter, "Takeshita et al."). The Examiner has stated that "In col. 2, lines 42-59, col. 3, lines 1-15 and Table 2, Takeshita et al. teach a rubber composition comprising an organic polymer, a filler and blocked mercaptosilanes represented by formulas (1) or (2) in applicant's presently claimed invention." (Office Action, page 4, paragraph 3). The compounds the Examiner has cited in Takeshita et al. disclose the use of compounds containing unsaturation  $\alpha,\beta$  to the carbonyl group of the thioester which has the undesirable potential to polymerize during the compounding process or during storage. Applicants note to the examiner that independent previously claimed and/or currently claimed Claims 1, 11, 20, 30 and 31; and the claims dependant thereon, all require that the mercaptosilane would not contain an  $\alpha,\beta$ -unsaturated carbonyl. Nowhere in Takeshita et al. is there any disclosure, motivation, hint or suggestion of using the presently claimed invention with mercaptosilane not containing an  $\alpha,\beta$ -unsaturated carbonyl. The Examiner is requested to indicate with specificity as to column and line number where there is any disclosure or suggestion of using the presently claimed invention with mercaptosilane not containing an  $\alpha,\beta$ -unsaturated carbonyl. In addition, it is noted that independent Claims 10 and 30 as previously claimed and/or currently claimed; and the claims dependent thereon, are not disclosed or suggested by Takeshita et al. In addition the Examiner is requested to indicate with specificity as to page and line number the disclosure or suggestion of a deblocking agent and a curing agent and the showing of allowing the composition to cure. Applicants contend that no such disclosure or suggestion has been provided or is known of in Takeshita et al. Absent such

noted disclosures or suggestions and in view of the foregoing it is respectfully requested that the rejections to Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 be withdrawn.

The Examiner has rejected Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 under 35 U.S.C. § 102 (b) as anticipated by Bell et al. U.S. Patent No. 3,922,436 (hereinafter, "Bell et al."). The Examiner has stated that "In col. 1, lines 64-69 and col. 5 and 6, Bell et al. teach a rubber composition comprising an organic polymer, a filler, and blocked mercaptosilanes represented by formulas (1) or (2) in applicant's presently claimed invention." (Office Action, page, 5, paragraph 4). Applicants disagree with the examiner's contentions. None of the compounds disclosed in Column 5 and 6 of Bell et al. disclose the previously claimed and/or presently claimed invention. The compounds in column 5 line 5 to column 6, line 15 do not disclose the previously claimed and/or currently claimed invention because the sulfur atom which bonds Y and G in formulas (1) and (2) is not present. It is noted to the Examiner that when Y is -SC(=O)-, the sulfur atom in -SC(=O)- is not the same sulfur atom as is bound between Y and G in formulas (1) and (2). Therefore formulas (1) and (2) contain an additional sulfur atom which is not disclosed or suggested by the compounds in column 5 line 5 to column 6, line 15. Furthermore the compounds disclosed in Column 6, line 16-to the end of column 6 do not contain any sulfur atoms at all and thus do not meet the limitations of formulas (1) or (2). In addition, there is no motivation, hint or suggestion of using sulfur atoms in the compounds disclosed in Column 6, line 16-to the end of column 6. The Examiner is respectfully requested to indicate with specificity as to column and line number where there is any disclosure or suggestion of an additional sulfur atom which is not disclosed or suggested by the compounds in column 5 line 5 to column 6, line 15 and/or where there is any disclosure or suggestion of using sulfur in the compounds of Column 6, line 16-to the end of column 6. In addition the Examiner is requested to indicate with specificity as to page and line number the disclosure or suggestion of a deblocking agent and a curing agent and the showing of allowing the composition to cure. Absent any such noted disclosures or suggestions it is believed that Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 are patentable over Bell et al and withdrawal of the rejection is respectfully requested.

The Examiner has rejected Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 under 35 U.S.C. § 102 (b) as anticipated by Seiler et al. U.S. Patent No. 4,060,539 (hereinafter, "Seiler et al."). The Examiner has stated that "In col. 1, lines 7-65 and col. 3, lines 63-67, Seiler et al. teach polymeric compositions comprising organic polymers, fillers, and blocked mercaptosilanes represented by formulas (1) or (2) of applicant's presently claimed invention, said blocked mercaptosilanes being produced from the reaction between a mercaptosilane and a monoacid anhydride corresponding to the thioester group present in the desired product." (Office Action, page 5, paragraph 5). The compounds the Examiner has cited in Seiler et al. disclose the use of compounds containing unsaturation  $\alpha,\beta$  to the carbonyl group of the thioester which has the undesirable potential to polymerize during the compounding process or during storage. Applicants note to the examiner that independent previously claimed and/or currently claimed Claims 1, 11, 20, 30 and 31; and the claims dependant thereon, all require that the mercaptosilane would not contain an  $\alpha,\beta$ -unsaturated carbonyl. Nowhere in Seiler et al. is there any disclosure, motivation, hint or suggestion of using the presently claimed invention with mercaptosilane not containing an  $\alpha,\beta$ -unsaturated carbonyl. The Examiner is requested to indicate with specificity as to column and line number where there is any disclosure or suggestion of using the presently claimed invention with mercaptosilane not containing an  $\alpha,\beta$ -unsaturated carbonyl. In addition, it is noted that independent previously claimed and/or currently claimed Claims 10 and 30; and the claims dependent thereon, are not disclosed or suggested by Seiler et al. If it is the examiner's contention that any of Claims 5, 12, 24, or 32 of the previously and/or currently claimed invention are disclosed by the structure disclosed in Column 1, lines 35-45 of Seiler et al., applicants disagree with such a contention. Even if applicants partially hydrolyzed mercaptosilane of Claims 5, 12, 24, or 32 were described in Column 1, lines 35-45 of Seiler et al., which applicants do not at all concede to, the noted disclosure in Seiler et al. contains an  $\alpha,\beta$ -unsaturated carbonyl, and thus does not meet the limitations of Claims 5, 12, 24, or 32. Nowhere in Seiler et al. is there any disclosure, motivation, hint or suggestion of using the presently claimed invention with mercaptosilane not containing an  $\alpha,\beta$ -unsaturated carbonyl. The Examiner is requested to indicate with specificity as to column and line number where there is any disclosure or suggestion of using the presently claimed invention with mercaptosilane not containing an  $\alpha,\beta$ -unsaturated carbonyl. In addition

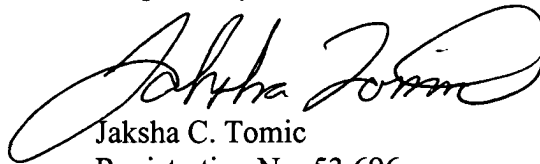
the Examiner is requested to indicate with specificity as to page and line number the disclosure or suggestion of a deblocking agent and a curing agent and the showing of allowing the composition to cure. Absent such noted showing of disclosures or suggestions and in view of the foregoing it is respectfully requested that the rejections to Claims 1-3, 5-15, 17, 18, 20-22, 24-35 and 37 be withdrawn.

The Examiner has provisionally rejected Claims 1-3, 5-15, 17, 18, 20-22, 24-35, and 37 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 25-32 of copending Application No. 09/986,515 or Claims 8-24 and 33-38 of copending Application No. 09/986,514. Although applicants disagree with the Examiner's contention that the conflicting claims are not patentably distinct; attached herewith is an executed Terminal Disclaimer that addresses the obviousness-type double patenting rejection over the copending cited applications. Language indicating that the undersigned attorney has the authority to execute the Terminal Disclaimer is included in the Terminal Disclaimer. Please charge the appropriate fee under 37 C.F.R. § 1.20 (d) to Deposit Account Number 07-0888. Also, in the event any extensions of time are required, please treat this paper as a petition to extend the time as required and charge Deposit Account No. 07-0888.

The Examiner has rejected Claims 1-3, 5-15, 17, 18, 20-22, 24-35, and 37 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 of U.S. Patent No. 6,127,468 or Claims 1, 2 and 6 of U.S. Patent No. 6,204,339. Although applicants disagree with the Examiner's contention that the conflicting claims are not patentably distinct; attached herewith is an executed Terminal Disclaimer that addresses the obviousness-type double patenting rejection over the cited patents. Language indicating that the undersigned attorney has the authority to execute the Terminal Disclaimer is included in the Terminal Disclaimer. Please charge the appropriate fee under 37 C.F.R. § 1.20 (d) to Deposit Account Number 07-0888. Also, in the event any extensions of time are required, please treat this paper as a petition to extend the time as required and charge Deposit Account No. 07-0888. It is noted for the record that applicants do not concede to any comments, remarks or statements made by the Examiner in the Office Action.

Early and favorable action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jaksha Tomic', written in a cursive style.

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